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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,663	03/30/2000	Bjorn Markus Jakobsson	Jakobsson 22-2	8288
46304	7590	08/08/2006	EXAMINER	
RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/538,663	<b>Applicant(s)</b> JAKOBSSON ET AL.	
	<b>Examiner</b> Stefano Karmis	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The following communication is in response to Applicant's appeal brief filed 18 May 2006.

#### ***Status of Claims***

2. Claims 1-6, 8-13 and 15-20 are currently pending.

#### ***Response to Appeal***

3. In view of the appeal brief filed on 18 May 2006, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Response to Arguments***

4. Applicant's arguments, see page 4 of Applicant's appeal brief, filed 18 May 2006, with respect to the rejection of claim 2 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. Therefore the rejection of claim 2 has been withdrawn.

5. Applicant's arguments filed 18 May 2006 with respect to the rejection of claims 1-6, 8-13 and 15-20 have been fully considered but they are not persuasive as discussed below. Therefore, claims 1-6, 8-13 and 15-20 stand rejected.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 8-13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Audebert U.S. Patent 6,694,436.

Regarding claims 1 and 10, Audebert discloses a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising: determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 9, lines 36-43 and column 10, lines 55-59);

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filtering out at a gateway of the communication system email directed to the particular receiver that does not comprise valid MAC information (column 10, lines 25-29 and column 11, lines 22-29); and providing the particular receiver with email directed to the particular receiver that comprises valid MAC information (column 21, line 39 thru column 22, line 12). Further, Applicant's own specification on page 9 states that, "MAC's are known to those skilled in the art and have been utilized in the past to authenticate email messages." Applicant then states that they have not been used to "avoid spam or categorize incoming mail." In response to this argument, the recitation of "preventing receipt by receivers of unwanted electronic mail messages" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant also argues that the MACs disclosed by Audebert are used in high-level requests or commands from application service providers, instead of emails between users. However, Audebert discloses that such electronic transactions comprise electronic mail messages (column 9, lines 36-40 and column 11, lines 1-25).

Claim 2, establishing a cookie which indicates to the particular receiver whether the particular sender has satisfied the requirement to allow the particular sender to become a registered sender, establishing an address related to an address associated with the particular

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receiver which will inform the particular sender that the particular receiver desires that the particular sender be able to send email to the particular receiver; and establishing by the particular receiver key which is forwarded to the particular sender by the particular receiver to inform the sender that the sender is authorized to send email the receiver and is now a registered sender and for use by the sender whenever the sender wishes to send email to the receiver (column 21, lines 39 thru column 22, line 21 and column 22, line 58-67).

Claims 3 and 11, generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the sender and receiver (column 4, lines 47-55 and column 13, lines 30-60).

Claims 4-6, 8, 9, 12, 13, 15 and 16, establishing an address comprises sending email from the particular receiver to the particular sender using public key encryption and determining whether the message has valid MAC information (column 12, lines 5-35).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Audebert U.S. Patent 6,694,436 in view of Holloway U.S. Patent 6,424,718.

Claims 17-20, Audebert fails to teach determining if the particular sender is a registered sender of the electronic message. Holloway teaches a data communications system using public key cryptography in a web environment in which users must register to utilize the system (column 3, line 51-65). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Audebert and include the teachings of Holloway because it provides a mechanism to enroll participants and provide more efficient security in their transmissions. Further, Holloway also teaches MAC validation of messages (column 8, lines 29-35).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Audebert teaches a system for performing secure electronic transactions that include electronic messages utilizing MACs and secret key encryption (column 9, lines 36-40 and column 11, lines 1-25) and Holloway teaches a data communications system using public key cryptography in a web environment in which users must register to utilize the system (column 3, line 51-65). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Audebert and include the teachings of Holloway because it provides a mechanism to enroll participants and provide more efficient security in the transmission of electronic messages.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
Stefano Karmis  
03 August 2006



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600